C. APPLICANT'S COMMENTS

Claims 1, 2, 7 and 8 are pending in this Application, with Claims 3-6, 9-16 cancelled, and with Claim 1 being amended. No new matter is added by way of these amendments, and the amendments are supported throughout the Specification and the drawings. Reconsideration of Claims 1, 2, 7 and 8 is respectfully requested. The Examiner's rejections will be considered in the order of their occurrence in the Official Action.

The Official Action rejected as-filed Claims 1-16 under 35 U.S.C. §103(a) as being unpatentable over Agans in view of Massie. The Applicant respectfully disagrees with this rejection of these claims, particularly as the same are now amended.

In proceedings before the United States Patent and Trademark Office, the Examiner bears the burden of establishing a prima facie case of obviousness based upon the prior art. *In re Bell*, 26 USPQ2d 1529, 1530 (Fed. Cir. 1993). *In re Oetiker*, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). When references cited by the Examiner fail to establish a prima facie case of obviousness, the rejection is improper and will be overturned upon appeal. *In re Fine*, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985).

"To establish a prima facie case of obviousness, three basic criteria must be met." MPEP §706.02(j). First, there must be some **suggestion or motivation**, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a **reasonable expectation of success**. Finally, the prior art reference (or references when combined) **must teach or suggest all the claim limitations**. The

teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

The law regarding *obviousness* is clear -- any modification of the prior art must be suggested or motivated by the prior art. It is submitted that combining elements from different prior art references (in an attempt to establish obviousness) must be motivated or suggested by the prior art.

> 'Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined only if there is some suggestion or incentive to do so.' [citation omitted] Although couched in terms of combined teachings found in the prior art, the same inquiry must be carried out in the context of a purported obvious "modification" of the prior art. The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.

In re Fritch, 972 F.2d 1260; 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992), (in part quoting from *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577; 221 USPQ 929, 933 (Fed. Cir. 1984)).

It is also submitted that the mere fact that one may argue that the prior art is capable of being modified to achieve a claimed structure does not by itself make the claimed structure obvious -- there must be a motivation provided by the prior art.

> The examiner finds the claimed shape would have been obvious urging that (our emphasis) "it is obvious for one skilled in the art to form each hook base of any desired shape *** since *this is within the capabilities of such a person.*" Thus, the examiner equates that which is within the capabilities of one skilled in the art with obviousness. Such is not the law. There is nothing in the statutes or the case law which makes "that which is within the capabilities of one skilled in the art" synonymous with obviousness.
>
> The examiner provides no reason why, absent the instant disclosure, one of ordinary skill in the art would be motivated to change the shape of the coil hooks of Hancock or the German patent and we can conceive of no reason.

Ex parte Gerlach and Woerner, 212 USPQ 471 (PTO Bd. App. 1980) (emphasis in original).

Independent Claim 1 now has the following features:

> 1. A tailgate controlled light system, comprising:
> **a light unit attached beneath a bedrail of a pickup box**;
> a **control switch** electrically connected to said light unit and engageable by a tailgate for opening said control switch, wherein said control switch is comprised of a depress switch and wherein said control switch is positioned to be engaged by said tailgate when said tailgate is closed within said pickup box; and
> **an override switch** electrically connected to said control switch;
> **wherein said override switch allows a user to terminate power to said light unit regardless of a position of said tailgate;**
> **wherein said override switch is attached to a sidewall of said pickup box**.

Agans (U.S. Patent No. 5,844,367) merely teaches an "auxiliary cap light kit". The Applicant admits that Agans teaches a light source (20) that is electrically connected to a switch (30) that is engaged by a tailgate (62) of a vehicle. Figures 1 and 7 of Agans are shown below.

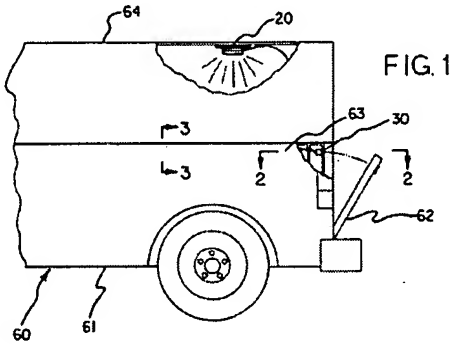


FIG. 1

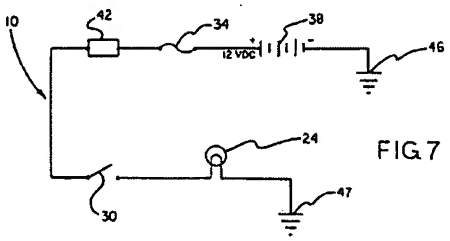


FIG. 7

Figures 1 and 7 of Agans

However, **Agans does not teach nor suggest an "override switch"** connected to the control switch. The Official Action attempts to use Massie (U.S. Patent No. 6,727,806) to show that:

> It would have been obvious to a person having ordinary skill in the art at the time the invention was made to incorporate the override switch as taught by Massie into the Agans type tailgate controlled light system, **because it would allow disabling of any warning system, i.e., allow a driver to turn the warning system off for those occasions when he desires to travel with the tailgate in the lowered position, thereby improving the efficiency of the system.**

The Applicant respectfully submits that the present invention is not a "warning system" and therefore there is no need for "disabling of any warning system." The present invention allows for the selective control of the "lighting" of the box of a pickup, not for providing a "warning system".

In addition, Agans does not teach "a light unit attached beneath a bedrail of a pickup box." As shown in Figure 1 of Agans, the light source (20) of Agans is attached to "***the cap interior side (65) [of] the truck bed cap (64)***" (e.g. a tonneau cover). *See* Columns 3-4, Lines 66-67, 1-3 of Agans. The "cap interior side" is not the same as a "bedrail" and is usually an aftermarket item which is well known in the art. The position of the light under the "bedrail of a pickup box" allows the present invention to be used with or without a "truck bed cap" while still providing adequate light within the interior of the pickup box.

Finally, none of the prior art patents teach or suggest "*wherein said override switch is attached to a sidewall of said pickup box*." This is another significant feature of the present invention which is accessible to the user when they open the tailgate (i.e. where and when the user **needs to see the interior of the pickup box**). Positioning the override switch in the cab of the pickup truck simply does not make sense and would not function adequately for the purpose of the present invention for obvious reasons.

Furthermore, there is no **suggestion or motivation**, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify Agans or to combine Agans with Massie (Massie is merely to prevent "*the continuous reminder from the buzzer 48 and the warning light*" if the tailgate is open –

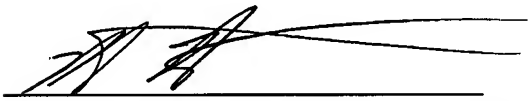
See Column 6, Lines 47-54). Second, there is no **reasonable expectation of success** of combining Agans with Massie (Massie does not teach an override switch connected in series with the control switch – *See* Figure 1 of present application and Figure 4 of Massie). Finally, Agans combined with Massie do **not teach or suggest all the claim limitations** shown in Claim 1 (see Claim 1 above).

For these reasons, among others, the combination of Agans with Massie cannot suggest the combination of features in applicant's Claims 1, 2, 7 and 8, particularly as the same are now amended, and it is therefore submitted that the rejection against these claims should be withdrawn and Claims 1, 2, 7, 8 allowed.

D. CONCLUSION

In light of the foregoing amendments and remarks, early reconsideration and allowance of this application are most courteously solicited. Should the Examiner consider necessary or desirable any formal changes anywhere in the specification, claims and/or drawing, then it is respectfully asked that such changes be made by Examiner's Amendment, if the Examiner feels this would facilitate passage of the case to issuance. Alternatively should the Examiner feel that a personal discussion might be helpful in advancing this case to allowance, they are invited to telephone the undersigned.

Respectfully submitted,



December 23, 2004
Date

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On December 23, 2004.

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